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|   |   |              |
|---|---|--------------|
| In re Application of: Rico Novella et al. | : |              |
| Application No.: 10/501211                | : |              |
| PCT Application No.: PCT/ES03/00008       | : |              |
| Int. Filing Date: 01 October 2003         | : | NOTIFICATION |
| Priority Date Claimed: 15 January 2002    | : | OF FEE DUE   |
| Attorney Docket No.:                      | : |              |
| For: METHOD OF SENDING AND VALIDATING     | : |              |
| DOCUMENTS                                 | : |              |

This notice is in response to an inquiry into the status of the above-identified application.

**BACKGROUND**

On 28 February 2005, a Notification of Missing Requirements (PCT/DO/EO/905) was mailed to the applicant, requiring the submission of a translation of the application into the English language, along with the payment of a surcharge of \$130 for the English translation, and setting a time period of two (2) months from the date of the notice or 32 months from the priority date, whichever is later, within which to submit the missing requirements.

On 21 April 2005, applicant filed an English translation along with an authorization to charge the corresponding fee. On 14 July 2005 a second English translation was received, and on 22 November 2005 a \$130 fee was charged to the applicant. The \$130 fee, however, was recorded as payment for a late oath or declaration for a Large Entity (fee code 1617), rather than payment for a late translation (fee code 1618), whereas a declaration had been submitted on 13 July 2004 along with the original papers requesting entry into the national stage in the United States. Moreover, \$65 of the fee was refunded to the applicant to reflect the fee for a late oath or declaration for a Small Entity (fee code 2617).

On 12 January 2006, a Notification of Defective Response (PCT/DO/EO/916) was mailed to the applicant, requiring the payment of additional claim fees of \$780 as a Small Entity, including a multiple dependent claim fee, along with the \$130 fee for a late translation. The Notification required the applicant to complete the response within a time limit of one month

from the date of the notice or within the time remaining in the period for response to the Notification of Missing Requirements, whichever is longer. The Notification of Defective Response indicated that no extension of the time limit would be permitted under 37 CFR 1.136, but extension of the period for response set in the Notification of Missing Requirements would be permitted under 37 CFR 1.136(a). The maximum extendable period under 37 CFR 1.136 for response to the Notification of Missing Requirements had expired as of the mailing date of the Notification of Defective Response. Consequently, the Notification of Defective Response effectively set a non-extendable period of one month to respond to the notice.

No response to the Notification of Defective Response mailed 12 January 2006 has been received.

### DISCUSSION

The evidence of record is that a translation of the application into the English language was filed on 21 April 2005 and again on 14 July 2005. An authorization to charge the requisite fee of \$130 for a late translation was received on 21 April 2005, and a fee of \$130 was charged to applicant on 22 November 2005, albeit for a late oath or declaration instead of for a late translation. The fact that the fee of \$130 was given the wrong fee code by the DO/EO should not be held against the applicant, nor should the fact that \$65 of the fee was mistakenly refunded by the DO/EO. The Notification of Missing Requirements did not set forth the requirement for the payment of additional claim fees of \$780 as a Small Entity, including a multiple dependent claim fee. Hence, the evidence of record is that prior to the mailing of the Notification of Defective Response on 12 January 2006, the applicant had filed a complete response to the Notification of Missing Requirements mailed on 28 February 2005. Consequently, the notification on 12 January 2006 indicating that the requirements set forth in the Notification of Missing Requirements had not been completed was in error. Moreover, the notification on 12 January 2006 set forth a new requirement, namely the payment of additional claim fees of \$780, without giving the applicant adequate opportunity in which to respond. Accordingly, the Notification of Defective Response (PCT/DO/EO/916) mailed 12 January 2006 is hereby **VACATED**.

Applicant needs to furnish an additional claim fee of \$805. (The Notification of Defective Response overlooked one additional claim.) In addition, the applicant needs to resubmit the \$65 of the processing fee for a late translation that was mistakenly returned to the applicant. Hence, the total fee required for this application is **\$870** for a Small Entity. **The applicant is hereby required to submit the \$870 fee within TWO (2) MONTHS from the date of this notice.** This period for response may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

### CONCLUSION

The Notification of Defective Response (PCT/DO/EO/916) mailed 12 January 2006 is **VACATED**.

The applicant is required to submit the \$870 fee within TWO (2) MONTHS from the date of this notice. This period for response may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

The application has an International Filing Date under 35 U.S.C. 363 of 01 October 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) of 21 April 2005.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) to await a response. Failure to properly respond will result in abandonment.

A copy of this notice MUST be returned with the response.



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